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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ian Daniel Von Fellenberg

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EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT

PAPER NUMBER

2876

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/521,124	<b>Applicant(s)</b> VON FELLEBERG ET AL.	
	<b>Examiner</b> JAMARA A. FRANKLIN	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7,9-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9-11, and 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/17/08 and 10/28/08</u> .                                    | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Acknowledgment is made of the amendment filed on September 05, 2008. Claims 1-4, 6, 7, 9-11, and 13-21 are currently pending.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-4, 6, 7, 10, 11, and 13-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Cobben et al. (US 6,786,513) (hereinafter referred to as 'Cobben').

Cobben teaches

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A method for verifying the authenticity of a document, wherein said document comprises a carrier with a plurality of perforations wherein at least part of the perforations have an elongate cross section with a minimum and a maximum diameter, the improvements comprising the steps of

viewing the document from at least one viewing direction that is non-perpendicular to a surface of the carrier (col. 5, lines 25-27); and

deriving the authenticity from an optical transmission of said perforations in said viewing (col. 3, lines 17-24); and

wherein said perforations extend through said carrier in a direction perpendicular to said surface (figure 4);

the method further comprising the step of comparing the optical transmission of said perforation with an expected optical transmission (col. 3, lines 17-24);

the method wherein the document is viewed from at least one direction that is perpendicular to a direction parallel to the maximum diameter of at least some of the perforations (document may inherently be viewed at any angle);

the method wherein the minimum diameter is substantially equal to or smaller than a thickness of the carrier (figures 1-4);

a security document comprising

a carrier; and

a security feature with perforations in said carrier,

wherein at least one of the perforations has an elongate cross section with a minimum and a maximum diameter,

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wherein at least two of the perforations have different cross sections (col. 4, lines 10-15 and lines 44-47);

wherein said perforations extend through the carrier perpendicular to a surface of the carrier, and

wherein said cross sections have equal areas (figures 3 and 4);

the security document wherein said plurality of perforations have equal area of cross section and therefore uniform transmission when being viewed from a viewing direction perpendicular a surface of said carrier (col. 3, line 65-col. 4, line 3);

the security document wherein said perforations form a human recognizable transmission pattern when viewed under an angle that is non-perpendicular to surface of the carrier (col. 4, lines 25-28);

the security document wherein each perforation has substantially uniform cross section through said document (figures 2-4);

the security document wherein the carrier is of flexible plastic or paper (col. 3, lines 53-57);

the security document wherein some of said perforations have circular cross section (col. 4, lines 38-40);

the security document wherein the minimum diameter is substantially equal to or smaller than a thickness of the carrier;

the security document wherein the minimum diameters of all perforations are equal, and parallel to each other;

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the security document wherein the maximum diameter is at least 1.5 times larger than the minimum diameter; and

the security document wherein the security document is a banknote or part of a passport (col. 3, lines 53-57).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cobben in view of Kimura et al. (JP 2000233561) (hereinafter referred to as 'Kimura').

The teachings of Cobben have been discussed above.

Cobben lacks the teaching of a first type of perforation having a first cross section and a second type of perforation having a second cross section.

Kimura, as cited by applicant, teaches  
a first type of perforation in a carrier having elongated cross section, and  
a second type of perforation in said carrier having a different cross section;  
wherein said first cross section is different from said second cross section but said first cross section has an equal area as said second cross section (figure 1a and abstract).

One of ordinary skill in the art would have readily recognized that providing the Cobben invention with a first type of perforation having elongated cross section and a second type of perforation having a different cross section would have been beneficial since the variety of spatial locations and arrangement of perforations could deter the possible copying of the perforations for fraudulent usage since the variety of arrangement would be difficult to reproduce. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Cobben with the aforementioned teaching of Kimura.

### ***Response to Arguments***

6. Applicant's arguments filed September 05, 2008 have been fully considered but they are not persuasive.

In response to the argument against the rejection of claim 1 arguing that Cobben does not teach or suggest non-perpendicular viewing of perpendicular perforations, that examiner contends that support against this argument is found in col. 5, lines 8-14 and col. 5, lines 25-27. In this instance the Cobben invention discusses at least some of the perforations extending at an

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angle differing from 90 degrees relative to the main plane of the document. Conceivably, if at least some of the perforations extend at an angle differing from 90 degrees relative to the main plane, then some other perforations may extend exactly at 90 degrees relative to the main plane of the document. Claim 4 of the Cobben invention further indicates that the aforementioned perforations present to the user an image which differs per angle of view, therefore indicating that the perforations are viewed at a plurality of angles.

In response to the argument against the rejection of claim 7, the examiner contends that the Cobben invention does indeed teach perpendicular perforations as indicated in figures 1, 4, 5, col. 4, lines 30-47, and col. 5, lines 8-14. Furthermore, in support of the rejection against the limitations of claim 7, the examiner contends that the Cobben invention teaches perforations having cross sections of various shapes including oval-shaped. An oval has a minimum diameter and a maximum diameter. In the instant that the Cobben invention is made of up more than one perforation having an oval shape, then that cross section of that one perforation is indeed "different" than the cross section of another perforation, as broadly interpreted.

In response to the argument against the rejection of claim 21, the examiner again contends that perpendicular perforations are discussed and illustrated throughout the Cobben invention. Furthermore, the combination of the Cobben and Kimura invention is relied upon to reject claim 21, whereas the Cobben invention is relied upon to teach the circular cross section and the Kimura invention is relied upon to teach the elongated cross section.



***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamara A. Franklin/  
Primary Examiner, Art Unit 2876

JAF  
December 01, 2008